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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,002	09/16/2003	Ranjan Mukherjee	D0295 NP	2334
23914	7590 05/30/2006		EXAM	INER
LOUIS J. WILLE			DUNSTON, JENNIFER ANN	
BRISTOL-M	YERS SQUIBB COMP.	ANY		
PATENT DEPARTMENT			ART UNIT	PAPER NUMBER
P O BOX 4000			1636	
PRINCETON, NJ 08543-4000			DATE MAILED: 05/30/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)		
	10/663,002	MUKHERJEE ET AL.		
Office Action Summary	Examiner	Art Unit		
	Jennifer Dunston	1636		
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with the c	orrespondence address		
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period w - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 16(a). In no event, however, may a reply be tim rill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONEI	lely filed the mailing date of this communication. D (35 U.S.C. § 133).		
Status				
1) Responsive to communication(s) filed on	action is non-final. ace except for formal matters, pro			
Disposition of Claims				
 4) ⊠ Claim(s) 1-16 is/are pending in the application. 4a) Of the above claim(s) is/are withdraw 5) ☐ Claim(s) is/are allowed. 6) ☐ Claim(s) is/are rejected. 7) ☐ Claim(s) is/are objected to. 8) ☒ Claim(s) 1-16 are subject to restriction and/or expressions. 	vn from consideration.			
Application Papers				
9) The specification is objected to by the Examiner 10) The drawing(s) filed on is/are: a) access Applicant may not request that any objection to the of Replacement drawing sheet(s) including the correction 11) The oath or declaration is objected to by the Examiner	epted or b) objected to by the Edrawing(s) be held in abeyance. See ion is required if the drawing(s) is obj	e 37 CFR 1.85(a). ected to. See 37 CFR 1.121(d).		
Priority under 35 U.S.C. § 119				
 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. 				
Attachment(s) 1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date	4) Interview Summary Paper No(s)/Mail Da 5) Notice of Informal P 6) Other:			

DETAILED ACTION

Claims 1-16 are pending in the instant application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, drawn to a method of identifying a peroxisome proliferator activated receptor modulator, comprising measuring the level of an mRNA transcript of a PPAR responsive gene, classified in class 435, subclass 6.
- II. Claims 6-10, drawn to a method of identifying a peroxisome proliferator activated receptor modulator, comprising measuring the level of protein expression of a PPAR responsive gene, classified in class 435, subclass 7.1.
- III. Claims 11-16, drawn to a method of identifying a peroxisome proliferator activated receptor modulator, comprising measuring the functional activity of a protein encoded by a PPAR responsive gene, classified in class 435, subclass 4.

The inventions are distinct, each from the other because of the following reasons:

The inventions of Groups I-III are biologically and functionally different and distinct from each other and thus one does not render the other obvious. The methods of Groups I-III comprise steps which are not required for or present in the methods of the other groups: measuring the level of an mRNA transcript of a PPAR responsive gene (Group I), measuring the level of protein expression of a PPAR responsive gene (Group II), and measuring the functional activity of a protein encoded by a PPAR responsive gene (Group III). The end results of the

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methods are different in that each method will result in the identification of a compound that is able to modulate gene expression, protein expression, or protein activity, respectively. Thus, the operation, function and effects of these different methods are different and distinct from each other. Therefore, the inventions of these different, distinct groups are capable of supporting separate patents.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper. Further, the search for each method requires a separate search of the patent and non-patent literature to search the method step(s) not shared with any other group. Therefore, the searches are not coextensive, and the additional searching that is required to search more than one group would impose a serious search burden.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In

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either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Dunston whose telephone number is 571-272-2916. The examiner can normally be reached on M-F, 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached at 571-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR, http://pair-direct.uspto.gov) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business

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Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's

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For all other customer support, please call the USPTO Call Center (UCC) at 800-786-

9199.

Jennifer Dunston, Ph.D.

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Examiner

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CELONE QIAN, PH.D. PRIMARY EXAMINER

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